CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by either submission using the EFS WEB submission system, fax to the U.S. Patent and Trademark office to fax number 571-273-8300, or is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 to on May 19, 2008.

/Brian C. Kunzler/
Attorney for Applicant

PATENT

Docket No. TUC920030104US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jean R. Chang et al.	)	
		)	
Serial No.:	10/648,064	)	
		)	Group Art
Filed:	August 26, 2003	)	Unit: 2162
		)	
For:	**SYSTEM METHOD AND APPARATUS FOR OPTIMAL PERFORMANCE SCALING OF STORAGE MEDIA**	)	
		)	
Examiner:	Dennis Y. Myint	)	
		)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request a Pre-Appeal Brief Conference. The following is a summary of the arguments of the Examiner and the Applicants on the disputed claims:

Rejection of claims 1, 4, 5, and 21 under 35 U.S.C. § 101

The Examiner rejected claims 1, 4, 5, and 21 under 35 U.S.C. § 101 as directed to non-statutory subject matter. In the response of April 21, 2008, Applicants submitted amendments to direct claims 1, 4, 5, and 21 to statutory subject matter that were not allowed. Applicants will cancel claims 1, 4, 5, and 21 or resubmit the amendments.

Rejection of claims 1, 4-5, 7, 10, 12-24 under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 4-5, 15-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al. (hereinafter Gelb) in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter Basham) and in further view of United States Patent Publication 2003/0193994 by Stickler (hereinafter Stickler). In addition, the Examiner rejected claims 7, 10, 12, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and Stickler and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter Bergsten). The Examiner further rejected claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten and in further view of "Active Storage for Large-Scale Data Mining and Multimedia" Proceedings of the 24th VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter Riedel). In addition, the Examiner rejected claim 24 sunder 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten, and in further view of United States Patent Publication 2003/0120379 by Mehlberg et al. (hereinafter Mehlberg).

Applicants responded by pointing out that claims 1, 7 and 15 include the limitations "...receive a dataset for storage on a magnetic tape storage medium **with a storage instruction that does not direct that the dataset is stored with scaling**..." and "...**select a scaling storage instruction in response to storage criteria applied to the storage characteristics that indicate scaling is beneficial** and communicate the selected scaling storage instruction to a storage controller, wherein the scaling storage instruction comprises an instruction to scale the magnetic tape storage medium to a predefined capacity for optimal data access performance and the storage controller stores the dataset on a magnetic tape storage device in response to the scaling storage instruction..." Claim 1. See also claims 7 and 15. Thus the present invention claims selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling.

The Examiner argues that Gelb's teaching of allocating a dataset to a non-SMS managed portion of the data processing system is analogous to receiving a dataset for storage on a magnetic tape storage medium with a storage instruction that does not direct that the dataset is stored with scaling. Office Action of Feb 21, 2008 (hereinafter OA080221), page 4, lines 8-10; page 20, line 16 – page 21, line 13. The Examiner further cites Basham's teaching of storing data sets in scaled partitions as disclosing selecting a scaling instruction. OA080221, page 6, lines 18-21.

Applicants respectfully traverse the rejection and submit that the combination of Gelb,

Basham, Stickler, and Bergsten do not disclose selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling. Gelb does teach selecting a storage class. Gelb, col. 18, lines 64 – col. 19, line 15; fig. 7, ref. 42. However, Gelb does not teach selecting a scaling instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial. OA080221, page 6, lines 3-10. The Examiner relies on Basham for this limitation. OA080221, page 6, lines 11-18.

However, Basham teaches away from selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling. Basham teaches storage segments for scaling are defined prior to writing data to a magnetic tape. Basham, col. 2, lines 53-55. Thus scaling is imposed on all stored datasets rather than scaling commands being selected in response to storage criteria.

In addition, an application may require assorted sizes of fixed-size partitions. Basham, col. 11, lines 25-29. Thus datasets may be communicated with scaling commands. However, Basham does not teach selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling. Specifically, there is no mention of selecting scaling when a dataset is received with a scaling instruction that does not direct scaling. Therefore Basham, and also Gelb, Stickler, and Bergsten do not teach all of the elements of the present invention.

Applicants therefore submit that claims 1, 7, and 15 are allowable under 35 U.S.C. § 103(a). Applicants further submit that claims 4, 5, 10, 12-14, and 16-24 are allowable under 35 U.S.C. § 103(a).as depending from allowable claims.

Respectfully submitted,

/Brian C. Kunzler/

Brian C. Kunzler
Reg. No. 38,527
Attorney for Applicant

Date: May 19, 2008
8 East Broadway, Suite 600
Salt Lake City, UT 84111
Telephone (801) 994-4646
Fax (801) 531-1929